



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

MAY - 1 2003

Paper No. 16

In re Application of :  
Kiyoshi Okamoto *et al* : DECISION ON PETITION  
Application No. 09/624,619 :  
Filed: July 24, 2000 :  
Attorney Docket No. CANO:011 :

This is a decision on the petition filed by facsimile transmission on March 12, 2003 by which petitioner requests withdrawal of the Notice of Non-Responsive Amendment mailed on November 5, 2002 and adhered to by the Primary Examiner on reconsideration. The petition is being considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

A review of the record shows that in reply to a rejection mailed on May 6, 2002, paper No. 6, petitioners filed an amendment and a petition for extension of time on August 15, 2002. See paper No. 7. Paper No. 12 sets forth the Primary Examiner's rationale for holding the amendment to be informal/nonresponsive (the inclusion in the amendment of changes to claim 11 that allegedly added "details that are not specific to the elected invention of Group IX". Petitioners filed a timely request for reconsideration, paper No. 13, and the Primary Examiner thereafter adhered to his position, paper No. 14.


Petitioners' arguments as presented in paper No. 13 and in the instant petition are persuasive. This is particularly so in light of the Primary Examiner's rationale for holding the amendment to be informal/nonresponsive, and the Primary Examiner's letter adhering to his position on reconsideration. With respect to the latter, it is irrelevant what the Primary Examiner "construed" the claim to cover when examining it for patentability. The issue is whether or not petitioners shifted inventions when amending claim 11. The Primary Examiner, who has conceded that his action is taken "according to the best understanding of the disclosure by the Examiner", cannot decide that the claim 11 was properly construed to read on one element of structure when the language of the claim does not limit it to solely that one element of structure.

Moreover, the Primary Examiner's reliance the language of claim 16, a member of a group of claims comprising a nonelected invention, as illustrating that claim 11 was originally limited to an invention other than now recited in the amended version of claim 11, is not persuasive. Claim 11 as originally filed included the limitation "detecting means for detecting an end position the sheet in a direction at a right angle relative to a conveying direction of the sheet". This limitation finds support page 14, lines 26-27, wherein the corresponding structure is disclosed as being sensor 93, which appears to correspond with the disclosure on page 5, lines 17 *et seq* of a "sheet end detecting means" which can move at a right angle relative to the conveying direction of the sheets. Claim 16 as originally filed added a limitation to the "sheet processing means" recited in claim 11, not to the "detecting means" of claim 11. Even if one considers claim 17, which in fact does further limit the "detecting means" of 11, it is clear from the disclosure that this detecting means is, structurally, element 93 and not sensor 31 which is, on page 14, line 26 described as "sheet detecting sensor 31, which appears to correspond to the disclosure in the sentence bridging pages 5 and 6 of a "sheet detecting means".

In summary, it appears that the Primary Examiner's position in refusing to enter the amendment filed on August 15, 2002 because the amendment to claim 11 added details "not specific to the elected invention", and thereby constituted "a shift in the middle of prosecution", was clearly erroneous.

This application is being returned to the Supervisory Patent Primary Examiner of Art Unit 3724 who shall instruct the Primary Examiner to take appropriate action consistent with this Decision, including entry of the amendment dated August 15, 2002 and examination of at least claims 11 and 12. The Supervisory Patent Primary Examiner is also directed to review the Primary Examiner's restriction requirement for compliance with the procedures set forth in Chapter 800 of the Manual of Patent Examining Procedure, and to consider whether the requirement as promulgated should be maintained, notwithstanding petitioners' election without traverse in paper No. 7.

PETITION GRANTED.

  
E. Rollins-Cross, Director, Patent  
Examining Groups 3710 and 3720

Rossi & Associates  
P.O. box 826  
Ashburn, VA 20146-0826